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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,726	12/03/2001	Leonardo W. Estevez	TI-31035	7169

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EXAMINER

DINH, TAN X

ART UNIT PAPER NUMBER

2653

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,726

Applicant(s)

ESTEVEZ, LEONARDO W.

Examiner

TAN X. DINH

Art Unit

2653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 and 29-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1) A Request for Continued Examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/02/2005 has been entered.

2) The preliminary amendment filed 11/02/2005 is acknowledged. Claim 28 has been canceled. News claims 32-44 are currently been added.

3) Claims 1-24,30,32,34,36-39,42 and 43 are rejected under 35 U.S.C. 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase " input/output " (claims 1-24,32,37-39,42 and 43) render(s) the claim(s) indefinite since it was not clear what applicant intended to cover between "input" and "output". The resulting claim(s), therefore, do not clearly set forth the metes and bounds of the patent protection desired.

The phrase " to an external base unit " (claims 1-4,16,36,37, 42 and 43) is unclear and cannot be understood. There is no "

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external base unit "in this invention and that would make the analog output/input connections connect to no where.

The phrase " may " (claims 2,14,36 and 42) render the claims indefinite. The phrase " may " refers to the potential of the device to function in two different directions. In this case, the user " may " enter the volume control via keypad and " may not " enter the volume control as claimed.

Claim(s) 2-12,14-24,30,32,34,37-39 incorporate the indefiniteness of claim(s) 1,13 and 36 by virtue of their dependency thereon.

4) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

5) (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6) Claims 1-25,27,29-31,36-39,42 and 43, as understood by the meaning of 112, 2nd above, are rejected under 35 U.S.C. 102(e) as being anticipated by MIN-JAE (6,222,807).

MIN-JAE discloses a self-contained portable music player as claimed in claim 1, comprising:

A rechargeable battery pack for powering the music player (column 17, lines 4-12);

an input/output device including at least a keypad for receiving user inputs and a display (Fig.4, input/output 56);

a memory capable of storing digital music in at least one compressed digital format (Fig.4, internal music storage 54);

a data processor connected to said input/output device and said memory to decompress said digital music into uncompressed digital music samples (Fig.4, CPU 51);

an audio coder-decoder connected to data processor for receiving uncompressed digital music samples from data processor and converting said uncompressed digital music samples into analog music (Fig.4, Encoder-Decoder 61 and 62);

a headset connector connected to audio coder-decoder for supplying analog music to an external headset earphone (Fig.2, headset 92);

a base connector including:

a power connection connected to rechargeable battery pack capable of receiving charging from an external base unit (Fig.2, connector 26. see also column 17, lines 4-12);

an analog output connection connected to audio coder-decoder for supplying analog music to an external base unit for amplification and reproduction via speakers (Fig.3, D/A converter 33, amplifier 34 and Speaker 35);

An analog input connection connected to said audio encoder/decoder for receiving an analog input from external based unit (Fig.3, connector ta3 for input analog audio signal from microphone or connector ta2 for input analog audio signal from another CD player. It is noted that, the claim did not recites the analog input is connected directly to audio coder-decoder. Further, the A/D converter could be embedded into encoder-decoder or separated as seen in figure 3, A/D 31, encoder 28);

the self-contained portable music player operates in a portable mode disconnected from a base unit and powered by battery pack and a user may listen to selected digital music stored in memory via an external headset earphone (figure 2, the self-contained portable music player 50 operates in a portable mode disconnected from a base unit 10, powered by battery pack and a user may listen to selected digital music stored in memory via an external headset earphone 92);

and in a base mode connected to a base unit via said base connector and powered via said power connector a user may listen to

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selected digital music stored in memory via speakers of an external base unit and wherein the a user may listen to music received on analog input connection of base connector (see figure 2, in base mode, the portable player 50 is connected to base 10 via connector 27 and the user may listen to music stored in memory of portable player 50 or from memory of base 10 to speaker 35 of base 10. It is noted that, the music files can be transferred from portable player 50 to base 10 or vice versa).

Claims 2-25,27,29-31 are rejected with the same reasons set forth in previously Office action.

Claims 36-38 are rejected with the same reasons set forth in claims 1 and 2.

Claims 42 and 43 are rejected with the same reasons set forth in claims 1 and 2.

7) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8) Claims 26 and 32-35 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over MIN-JAE (6,222,807).

MIN-JAE discloses all the subject matter as claimed in claims 26, 40 and 41, except to specifically show that the base unit receives the volume control from the portable player. It would have been obvious to someone within the level of skill in the art at the time of the invention was made to modify the audio player system of MIN-JAE by locating a volume control in portable player. The rationale is as follows: The volume controller is old and widely used in the recording art for controlling the volume of the audio signal (See MIN-JAE's figure 2, control button Ka, portable player 50 with various control buttons), the volume controller can be placed at any suitable locations on any audio players. Therefore, one of ordinary skill in the art at the time of the invention was made would have been motivated to arrange a volume control on portable player 50 of MIN-JAE's audio player system for controlling the volume of the base unit 10 as claimed.

As to claims 32-35 and 44, to locate the volume control and selection input in any suitable locations of the audio player system is found to be within the level of skill in the art.

9) Applicant's arguments filed 11/02/2005 have been fully considered but they are not persuasive.

First, the analog input connected to coder-decoder is shown in MIN-JAE's figure 3, analog input ta3 or ta2. The claims did not

recite the analog input is connected directed to coder-decoder therefore, the teaching of MIN-JAE's figure 3 could read on the claim language.

Second, claims 2,14,36,38 and 40 recites that the user "may" enter column control data from portable player to base unit. The phrase "may" did not guaranty that the user have to enter column control data from portable player to base unit as claimed. Further, to design a volume control on portable player for controlling the volume on the base unit is found to be within the level of skill in the art.

Third, the tuner is shown in MIN-JAE's figure 3 and in column, 8, lines 58-63. It is noted that claims 13 and 25 did not specific recite the portable player having a tuner and applying analog audio signal to base unit as applicant's argued.

Fourth, the bidirectional digital data bus is shown in MIN-JAE's figures 3 and 4, the data.

Fifth, the volume control unit can be arranged at any suitable locations in the audio system for controlling either the portable player or base unit. This feature is found to be within the level of skill in the art.

For those reasons, the claims are still rejectable as shown above.

10) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN XUAN DINH whose telephone number is (571)272-7586. The examiner can normally be reached on MONDAY-FRIDAY from 8:00AM to 5:00PM.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


TAN DINH
PRIMARY EXAMINER

November 9, 2005